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10/694,074	10/27/2003	Nathan R. Belk	MICP.P0101US	3795
29053 7590 09/02/2010 FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NATHAN R. BELK

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Appeal 2010-014746  
Application 10/694,074  
Technology Center 2600

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Before KENNETH W. HAIRSTON, JOHN C. MARTIN and  
MAHSHID D. SAADAT, *Administrative Patent Judges*.  
HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is an appeal under 35 U.S.C. §§ 6(b) and 134 from the final rejection of claims 1 to 8, 10, 11, 26, and 27. We will reverse.

The disclosed invention relates to a system that includes a filter for filtering a number of undesired channels from an input signal, and a tuner for receiving the output of the filter and for communicating a number of channels less than the number of channels at the output of the filter. At least a portion of the filter and at least a portion of the tuner are formed on an integrated circuit (Fig. 1; Spec. 3-10; Abstract).

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. A system, comprising:

a filter operable to receive an input signal comprising a first number of television channels and further operable to communicate an intermediate output signal comprising a second number of television channels less than the first number of television channels, wherein at least a portion of the filter is formed on an integrated circuit so as to dissipate a plurality of undesired channels associated with the input signal in elements of the integrated circuit such that at least a portion of the undesired signals are not reflected back to a transmitter of the input signal; and

a tuner coupled to the filter and operable to receive the intermediate output signal and further operable to communicate an output signal comprising a third number of television channels less than the second number of television channels, wherein at least a portion of the tuner is formed on the integrated circuit.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Birleson	US 6,177,964 B1	Jan. 23, 2001
Fulga <sup>2</sup>	US 7,196,737 B1	Mar. 27, 2007

The Examiner rejected claims 1 to 8, 10, 11, 26, and 27 under 35 U.S.C. § 103(a) based upon the teachings of Birleson and Fulga.

According to the Examiner (Final Rej. 3), the preferred embodiment in Figure 1 of Birleson describes a filter 101 on the front end of a tuner that lets all television channels input the tuner, whereas the prior art in Figure 4 of Birleson describes a conventional filter 404 on the front end of a tuner that filters television channels prior to input to the tuner. The Examiner indicates (Final Rej. 3) that “by simply replacing the filter 101 of Birleson with the conventional filter, would render obvious the pending claims.”

Appellant argues *inter alia*:

*Birleson* not only teaches away from using “a filter operable to receive an input signal comprising a first number of television channels and further operable to communicate an intermediate output signal comprising a second number of television channels less than the first number of television channels,” as recited, in part, in Claim 1, but also explicitly rejects an input filter as a solution. *Birleson* states that input filters are “a critical drawback” that had to be eliminated. *Birleson*, Col. 3, lines 19-21.

(App. Br. 15).

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<sup>2</sup> Filed on January 24, 2003.

According to Appellant (App. Br. 14,15), Fulga, like Birleson, also teaches away from the claimed technique because he adopted the Birleson technique of using an input filter that “passes all channels in the television band” (col. 2, ll. 64-67).

Based upon the foregoing, we have to determine whether the Examiner erred by combining input filter teachings from the Figure 4 prior art embodiment in Birleson with the Figure 1 preferred embodiment in Birleson.

Birleson describes performance problems with the input filter in prior art Figure 4, and states that “[t]his was a critical drawback of previous tuners that had to be eliminated because it is a source of tremendous error and distortion, as well as complexity” (col. 3, ll. 13 to 21).

In view of such an express teaching in Birleson that the Figure 4 prior art input filter led to problems that had to be eliminated, we agree with Appellant that Birleson clearly teaches away from modifying the preferred embodiment in Figure 1 with the problematic input filter from the Figure 4 prior art embodiment. We also agree with Appellant that the teachings of Fulga merely endorse Birleson’s preferred Figure 1 embodiment that uses a filter that “passes all channels in the television band.”

In view of the clear teaching away by Birleson, the Examiner erred by combining the input filter teachings from the Figure 4 prior art embodiment in Birleson with the Figure 1 preferred embodiment in Birleson.

In summary, the obviousness rejection of claims 1 to 8, 10, 11, 26, and 27 is reversed because we agree with Appellant’s teaching away argument.

The decision of the Examiner is reversed.

REVERSED

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